UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Offic
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/122,576	07/24/98	SIEV D	CVS-1

HM12/1221

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EXAMINER	
MCCARTHY III, T	
ART UNIT	**PAPER NUMBER**
1618	7

DATE MAILED: 12/21/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/122,576	Siev et al.
Examiner	**Group Art Unit**
McCarthy, T.C.	1618

☒ Responsive to communication(s) filed on *Jul 24, 1998*.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *one* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-116* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims *1-116* are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Response to Traversal

1. Applicant's election with traverse of the restriction requirement in Paper No. 6 is acknowledged. The traversal is on the ground(s) that the different methods for derivatizing resins to obtain a generic resin of formula I are species of claim 1 - not distinct inventions. This argument is persuasive. Therefore, the examiner has withdrawn the previous restriction requirement and has rewritten it in the form presented below.

Election/Restriction

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claim 1-27, 29-32, 34-76, 78-101, and 103-116, drawn to a method for derivatizing a resin, classified in class 436, subclass 85.

II. Claim 28, 33, 77, and 102 drawn to methods of purification, classified in class 436, subclass 518.

3. The inventions are distinct, each from the other because of the following reasons:

4. Invention I is drawn to a method used to produce derivatized resins whereas invention II is practiced to purify compound mixtures. Therefore, the steps used and purpose for practicing invention I are different from those of invention II, such that art reading on one method would not read on the other. Restriction in this case is therefore proper.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Election of Species

7. This application contains claims directed to the following patentably distinct species of the claimed invention: methods of derivitizing resins. Applicant has claimed a large number of processes for derivatizing resins, such that several distinct compounds result from these processes (e.g. resins, derivatized resins, derivitized resins with linkers, and derivatized resins with linkers and peptides, libraries, single compounds, etc.), but which also fall within the broad

definition of Formula I (claims 1, 32, 56, 79, and 116). The processes use different reagents and steps, and result in products that have different structures/structural elements, such that art reading on one method would not render the others obvious - absent ancillary art. Applicant is therefore required to elect a single unique process wherein all the reagents used are defined (i.e. R4, X, Y, Z, and the resin type are all defined), and such that a single and unique product/compound is produced. For example, election of claim 106 might be considered responsive. Likewise, election of any one of claims 107, 108, 109 or 110 - along with election of a single specific argininal - might be considered responsive.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 32, 56, 79, 106, 111, and 116 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner T.C. McCarthy whose telephone number is (703) 308-5316.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald E. Adams, can be reached on (703) 308-0570. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

KEITH D. MacMILLAN
PRIMARY EXAMINER

December 15, 1999

T.C. McCarthy III, Ph.D.